

III. REMARKS

Claims 3 and 9 have been amended above. Claims 1-9 remain pending in the instant application.

The Examiner has objected to the Specification because of the term index/indexation/indexing. This term is well understood in the art and deals with mechanical/machinery indexing (i.e. the accurate placement/positioning of a part relative to another part; e.g. indexing gears, etc.). The objection should be withdrawn.

Claims 3 and 9 have been rejected under 35 U.S.C. 112, Second paragraph for being indefinite. Claims 3 and 9 have been amended to overcome the rejection. However, as noted before in Applicant's earlier response the arguments of which are incorporated by reference herein, Claims 3 and 9 prior to amendment satisfied the definiteness criteria under 35 U.S.C. 112, Second paragraph. The amendment to the claims has been made to expedite prosecution of the case. Accordingly, this amendment should not be considered a narrowing amendment made for patentability reasons.

Claims 1 and 3 have been rejected under 35 U.S.C. 102 as being anticipated by Kuwata. The Applicant respectfully disagrees.

Claim 1 calls for the two stop arms (on the side opposite the hinged side of the closing cover) being located away from lateral sides of the closing cover. In Kuwata, as seen clearly in Fig. 1, the engaging/releasing arms 15A, 15B are located directly on the lateral sides of the cover section 3. Merely because the engaging/releasing arms 15A, 15B are located downwardly offset from the top most lateral edges, as pointed

out by the Examiner, does not locate the arms away from the lateral sides of the cover as called for in claim 1. On the contrary, in Kuwata the engaging/releasing arms 15A, 15B on the cover 3 are precisely on the lateral sides of the cover 3.

It is further noted that in the Office Action, the Examiner incorrectly relies on the holding in In re Hutchinson, 69 USPQ 138, (CCPA 1946) for the proposition that the phrase in claim 1, "the [stop arms being] adapted to be folded against one another at the cover in order to cause the cover to open" is not given patentable weight. The Examiner has mischaracterized the holding in In re Hutchinson. The CCPA in In re Hutchinson, was addressing something different than the features of claim 1 in the instant application. The CCPA in In re Hutchinson, was addressing the patentable weight given to the phrase "[an] article adapted for use in making a template" included in the preamble of a claim. (Although, the CCPA held that the phrase "an article adapted for use in..." in the claim preamble was not a patentable limitation, more recent cases state that intended use, even in the preamble, may further limit the claim if the intended use results in a structural difference between the claimed invention and the prior art. See MPEP 2111.02; citing In re Otto 136 USPQ 458, 459 (CCPA 1963)). The phrase in claim 1 is not in the preamble. Also, the phrase in claim 1 is not that the stop arms are adapted to be used or for use in some way to cause the cover to open, but rather that the "stop arms are adapted to be folded against each other at the cover to cause the cover to open". The language in claim 1 is not merely an intended use (as addressed in In re Hutchinson), but serves to precisely define structural attributes of interrelated component parts recited in the claim. By way of example, in order to be adapted to be folded against each other at the cover to cause

the cover to open the two stop arms as called for in claim 1, must have a flexible structure (e.g. resiliently flexible members) and engagement features (e.g. tabs, fingers, etc.) which effect the folding of the arms against one another at the cover and release of the cover during the folding. These are structural attributes. It has long been held that language such as "members adapted to be positioned" serves to precisely define structural attributes of interrelated component parts of the claimed assembly, and as such cannot be ignored. In re Venezia, 189 USPQ 149 (CCPA 1976). In Kuwata, it is the side walls 7 on the base section 2 that are deflected by coming action of release arms 15B to release the cover 3. The release arms 15B are flexed upwards and not folded against one another at the cover. The engaging arms 15A in the cover are not flexed or folded in any way to release the cover. Hence, nowhere does Kuwata disclose stop arms on the cover adapted to be folded against each other to cause the cover to open as otherwise called for in claim 1. Claims 1-7 are patentable over the cited prior art.

Claims 2, 6, 8 and 9 have been rejected under 35 U.S.C. 103 as being unpatentable over Kuwata in view of Matsuoka. The Applicant respectfully disagrees.

The Examiner has failed to establish a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2143. As noted before in the Applicant's prior amendment, the arguments of which are incorporated by reference herein, there is simply no motivation or suggestion in either Kuwata or Matsuoka nor in any other reference cited by the Examiner that would make it obvious for one skilled in the art to combine these references. As noted before, the cover 3 in Kuwata, and the retaining bars 8 in Matsuoka are structurally so disparate and operate in so very different ways that there simply is no suggestion arising from the references themselves for one skilled in the art to combine the reference. The factors cited by the Examiner on page 6 of the Action and attributed to Matsuoka (i.e. reduction in size and thickness of the cover, or more effective heat dissipation) are indeed general in nature, and do not and cannot overcome the structural differences between the cover 3 in Kuwata and retaining bars 8 in Matsuoka that prevent combining Kuwata and Matsuoka as suggested by the Examiner. For example, it is the front cross span member of the cover 3 in Kuwata that enables the long/slender flexible arms supporting releasing arms 15B to operate as disclosed in Fig. 5 in Kuwata (the Examiner is directed to pages 8-9 of the previous amendment where the structure and operation of the releasing arms 15B is explained in detail). Contrary to the disclosure in Kuwata, the retaining bars 8 in Matsuoka, must be flexed inwards to engage/release, and by necessity cannot have a cross span member tying the retaining bars 8 together (as otherwise used in the Kuwata cover). The motivation asserted by the Examiner of reducing structure, or more effective heat dissipation does nothing to overcome or correct the aforementioned structural disparity so

as to make it obvious to one skilled in the art from these two references alone (or anything else cited by the Examiner) to combine these references. Not only does the incongruity between the disclosures in Kuwata and Matsuoka not give rise to motivation to combine the references, but it also does not give rise to a reasonable expectation of success. (The proposed modification cannot change the principle of operation of a reference, MPEP 2143.02 which is precisely what happens when combining Kuwata and Matsuoka). The Examiner is correct when stating that the test for obviousness is based on what the combined teachings of the references would have suggested to one skilled in the art. However, that suggestion is not some unknown factor, but rather the suggestion is precisely and only what is suggested in the references themselves, no more, no less.

Further, the Examiner is incorrect when stating "nor is [the test for obviousness] that the claimed invention be expressly suggested in any one or all the references." On the contrary, the third criteria for establishing a prima facie case of obviousness is exactly that the prior art reference must teach or suggest (i.e. expressly or inherently) all the claim features. Kuwata and Matsuoka (even if they could be combined as suggested by the Examiner) do not disclose or suggest all the features called for in claims 8 and 9.

Claims 8 and 9 are similar to claim 1 in that amongst other features they call for two stop arms (on the side opposite the hinged side of the closing cover) being located away from lateral sides of the cover. As noted before, Kuwata does not disclose this, and nor does Matsuoka. The pawls 7 in Matsuoka are located on the lateral sides of the cover. Kuwata and

Matsuoka also fail to disclose or suggest three slots (defined by the two bars forming the stop arms) all open on one side of the cover. Clearly the recesses formed by the opposing pawls 7 in Matsuoka open on opposite sides not on one side of the cover. Furthermore, the recesses formed by the pawls 7 are merely an elbow recess which is not at all the same as a slot. Claims 8 and 9 are patentable over the cited prior art and should be allowed.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



Janik Marcovici

Reg. No. 42,481

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

9/22/03

Date

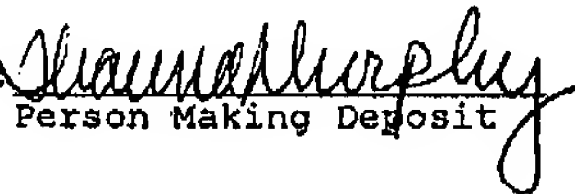
CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted by facsimile to 703-308-7724 the date indicated below, addressed to the Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Date:

9/23/03

Signature:


Person Making Deposit

Facsimile Message From
Law Offices
PERMAN & GREEN, LLP
425 Post Road
Fairfield, Connecticut 06430 USA

Facsimile Number: (203) 255-5170

Telephone Number: (203) 259-1800

Art Unit 2833

TO: Examine Figuerola

FAX NO: 703-308-7724

DATE: 9/23/03

FROM: Janik Marcovici

RE: 09/991,292

P&G Reference: 680-010648-USLPAK

FAX RECEIVED

SEP 23 2003

Number of Pages, including this sheet, being transmitted: 12

TECHNOLOGY CENTER

➤ Please confirm receipt of this transmission

☐ The original of this facsimile will be sent to you via mail

THIS FACSIMILE MESSAGE IS INTENDED ONLY FOR THE USE OF THE ADDRESSEE
AND MAY CONTAIN CONFIDENTIAL OR LEGALLY PRIVILEGED INFORMATION

If you are not the intended recipient you are hereby notified that any use or dissemination of this communication is strictly prohibited. If you receive this transmission in error please notify us immediately so that we can arrange for the return of the documents to us at no cost to you.